

REMARKS

I respectfully request reconsideration of the above-identified patent application in view of the foregoing amendments and following remarks. Specifically, I have amended claim 1 to add a computer readable database to the caching step. Support for this amendment is found in the specification page 3 line 0084 relating to the software (only executable by a computer system) and the computer actions of the process on page 4 line 0088. Claims 2 and 11 were amended to remove the term "about" in two places in each claim. Lastly, claims 2-5 and 10 were each amended to place the claims in proper dependent form. Entry of the foregoing amendments is respectfully requested. Claims 1-17 are pending.

35 U.S.C. §101 Rejection

Claims 1-4 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Specifically, the Examiner alleges that the claimed method could be performed "without the aid of any technology." I submit that the foregoing amendment to claim 1 obviates this rejection.

Claim 1 was amended to add a technological component in the caching step. Support for the amendment is found in the specification, particularly on pages 3-5 where a computer system is the only way to implement the described process. Accordingly, the amendment to claim 1 and format amendment to claims 2-4 obviate this rejection.

35 U.S.C. §112 Second Paragraph Rejection

Claims 2 and 11 were rejected under 35 U.S.C. §112 second paragraph as indefinite in the use of the term "about" in describing a range of digit lengths. Claims 2 and 11 were amended to obviate this rejection.

35 U.S.C. §103 Rejection

Claims 1-8 and 10-17 were rejected under 35 U.S.C. §103 as obvious over Herr-Hoyman (US5,727,156) in view of Perkowski (US6,625,581). The Examiner described this rejection on a claim-by-claim basis. I shall respond as well on a claim-by-claim basis. It should be noted that independent claim 9 was found allowable over the cited art.

With regard to claim 1, the Examiner appears to be alleging that Herr-Hoyman discloses or suggests any of the second and third steps of the claimed process, but does not disclose step (a) of claim 1 ("providing each media article with an alphanumeric code having regions in the code for publication source, publication date, article identification"). Instead, the Examiner seems to be alleging that the secondary reference Perkowski discloses step (a) of the inventive process of claim 1 by pointing to Figure 4A1 and column 4 lines 31-47. Therefore, I respectfully traverse the

rejection of claim 1 because (1) a *prima facie* case of obviousness has not been established, (2) the combination of references, even if they could be properly combined, does not disclose or suggest the invention of claim 1, (3) there is no suggestion in either prior art reference to suggest their combination, absent hindsight gleaned from the claimed invention, and (4) the references cited are not analogous to the field of the present invention or the problem solved by the present invention.

Claim 1 is directed to "a process for storing and accessing information from publishers electronically." The inventive process comprises three steps. In order for a *prima facie* case of obviousness to be established, the two cited references must disclose or suggest all three steps and there must be some expressed suggestion in the cited references to suggest that their disclosures be combined in a certain way. Neither required disclosure is present in the combined disclosure of Herr-Hoyman nor Perkowski.

Specifically, the Examiner alleges that Herr-Hoyman discloses step (b) of claim 1 in Figure 4. Step (b) is a caching step that uses the alphanumeric code generated in step (a). Since Herr-Hoyman does not generate the alphanumeric code as is admitted by the Examiner, Herr-Hoyman cannot disclose a step for caching such a code. Moreover, Figure 4 in Herr-Hoyman contains a complicated process wherein one particular "local storage" box cannot be taken out of context because it stores "e-Card data." According to Herr-Hoyman column 4 lines 9-17, the e-Card data requires credit card information "and thus serves as charge authorization." Accordingly, Herr-Hoyman does not disclose or suggest step (b) because Herr-Hoyman is concerned with purchasing access and not an article storage and retrieval system.

The Examiner further alleges that Figure 5 of Herr-Hoyman discloses "associating the code with each article published to allow for retrieval of the article through accessing the table." (emphasis added) It appears that the Examiner has simply copied the words of step (c) and pointed to Figure 5. But where in Figure 5 is "the table?" Is it the "E-Card DB" that we know contains credit card information? Is it "customization data" that is not even described in the Herr-Hoyman specification text? Is it a "look up ID (S42)" that appears to be customer identification data (not a media article alphanumeric code)? Therefore, none of the many components of Figure 5 appear to disclose or suggest step (c) of the claimed invention.

Step (a) is alleged to be disclosed in Perkowski. But that disclosure in Perkowski is stated by the Examiner to be "a wallet transaction" processing means. Since Perkowski is concerned with consumer product purchasing, it is non-analogous and does not disclose the notion of a media article containing the stated information in an alphanumeric code.

Accordingly, a *prima facie* case of obviousness has not been established because Herr-Hoyman does not disclose or suggest steps (b) and (c) and Perkowski does not disclose or suggest step (a). Even if there is a proper combination of Herr-Hoyman and Perkowski, the combined disclosure does not disclose or suggest the assignment of an alphanumeric code to media articles,

does not disclose or suggest the caching step to form the table and does not disclose in step (c) how articles are retrieved through association with the table. Therefore, the combination of the primary and secondary references does not disclose or suggest the entire invention of claim 1.

In addition, a combination of references requires that there be some expressed suggestion for their combination found in the cited references and not gleaned from the present patent application. The Examiner has not pointed to where such a required suggestion for combination could be found. No such suggestion even exists because the two references are from non-analogous art (from each other). Herr-Hoyman is concerned with an automatic publishing system (note not a retrieval system) that has a required E-Card system needed to obtain payment for the publishing service provided. Perkowski, by contrast is directed to purchasing consumer products on the Web, a very different process and issue. Therefore, the Examiner has tried (unsuccessfully) to find unrelated bits of claim 1 in various complicated figures in two unrelated patents. Accordingly, the obviousness rejection is overcome because there is no required and expressed suggestion to combine the primary and secondary references.

Accordingly, in view of the facts that (1) a *prima facie* case of obviousness has not been established, (2) the combination of references, even if they could be properly combined, does not disclose or suggest the invention of claim 1, (3) there is no suggestion in either prior art reference to suggest their combination, absent hindsight gleaned from the claimed invention, and (4) the references cited are not analogous to the field of the present invention or the problem solved by the present invention, claim 1 is patentable over Herr-Hoyman in view of Perkowski. I respectfully request withdrawal of this rejection of claim 1.

Claims 2-8 are dependent on claim 1 and add further limitations to claim 1. As claim 1 is patentable over Herr-Hoyman, the added limitation of claim 2 regarding the range on lengths of the alphanumeric code is also patentable over Herr-Hoyman. Moreover, the cited passage of Herr-Hoyman (column 3 lines 57-67) does not disclose or suggest the length of an alphanumeric code or the information contained in such a code (described in step (a) of claim 1). Similarly, the passage in Herr-Hoyman for the claim 3 limitation also does not make sense and is unrelated to the claim 3 limitation. In each dependent claim, each of claims 2-8 also incorporates the limitations of claim 1. Therefore, since claim 1 is patentable over Herr-Hoyman (with or without Perkowski), each dependent claim is also patentable because the subject matter in each dependent claim further limits the subject matter of claim 1. Accordingly, claims 1-8 are patentable over Herr-Hoyman in view of Perkowski.

Claim 9 was found to be patentable by the Examiner.